

IFW

Practitioner's Docket No. 1941/172 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Zimmerling, et al

Application No.: 10/726,066

Group No.: 3751

Filed: Dec. 2, 2003

Examiner: Rost, Andrew J.

For: Fluid Switch Controlled Transcutaneously via a Magnetic Force

Mail Stop Amendment

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

TRANSMITTAL OF INFORMATION DISCLOSURE STATEMENT  
BEFORE MAILING DATE OF EITHER A FINAL ACTION  
OR NOTICE OF ALLOWANCE (37 C.F.R. § 1.97(c))

03/06/2006 HTECKLU1 00000006 10726066 TIME OF TRANSMITTAL OF ACCOMPANYING  
01 FC:1806 180.00 OP INFORMATION DISCLOSURE STATEMENT

1. The information disclosure statement transmitted herewith is being filed *after* three months of the filing date of this national application or the date of entry of the national stage as set forth in Section 1.491 in an international application or after the mailing date of the first Office action on the merits, whichever event occurred last but *before* the mailing date of either

- (1) a final action under § 1.113 or  
(2) a notice of allowance under § 1.311

CERTIFICATION UNDER 37 C.F.R. §§ 1.8(a) and 1.10\*

(When using Express Mail, the Express Mail label number is *mandatory*;  
Express Mail certification is *optional*.)

I hereby certify that, on the date shown below, this correspondence is being:

MAILING

[x] deposited with the United States Postal Service in an envelope addressed to the Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

37 C.F.R. § 1.8(a)

[x] with sufficient postage as first class mail.

37 C.F.R. § 1.10\*

[ ] as "Express Mail Post Office to Addressee"

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TRANSMISSION

[ ] facsimile transmitted to the Patent and Trademark Office, (703) -

Date: 2/28/06

Jay Sandvos  
Signature

Jay Sandvos  
(type or print name of person certifying)

\* Only the date of filing (§ 1.6) will be the date used in a patent term adjustment calculation, although the date on any certificate of mailing or transmission under § 1.8 continues to be taken into account in determining timeliness. See § 1.703(f). Consider "Express Mail Post Office to Addressee" (§ 1.10) or facsimile transmission (§ 1.6(d)) for the reply to be accorded the earliest possible filing date for patent term adjustment calculations.

whichever occurs first.

### **FEE**

2. Accompanying this transmittal is the fee for submission of an information disclosure statement under section 1.97(c). (\$180.00)

### **FEE PAYMENT**

3. Applicant elects the option to pay the fee set forth in 37 C.F.R. § 1.17(p) for submission of an information disclosure statement under § 1.97(c) (\$180.00).

Fee due \$180.00

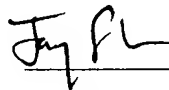
### **METHOD OF PAYMENT OF FEE**

4. Attached is a check in the amount of \$180.00

Charge any additional fees required by this paper or credit any overpayment to Deposit Account No. 19-4972.

A duplicate of this paper is attached.

DATE: 2/28/06



Jay Sandvos  
BROMBERG & SUNSTEIN LLP  
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US

01941/00172 471624.1



Practitioner's Docket No. 1941/172 PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Patent application  
of \_\_\_\_\_

Inventor(s)

for \_\_\_\_\_

Title of invention

the specification of which is being transmitted herewith

OR

In re application of: Zimmerling et al

Application No.: 10/726,066

Group No.: 3751

Filed: Dec. 2, 2003

Examiner: Rost, Andrew J.

For: Fluid Switch Controlled Transcutaneously via a Magnetic Force

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

CERTIFICATION UNDER 37 C.F.R. SECTIONS 1.8(a) and 1.10\*

(When using Express Mail, the Express Mail label number is **mandatory**;  
Express Mail certification is optional.)

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37 C.F.R. SECTION 1.8(a)

37 C.F.R. SECTION 1.10\*

[ ] with sufficient postage as first class mail.

☐ as "Express Mail Post Office to Addressee"

Mailing Label No. \_\_\_\_\_ (mandatory)

TRANSMISSION

☐ transmitted by facsimile to the Patent and Trademark Office.

Signature

Date: 2/29/06

Jay Sandvos

(type or print name of person certifying)

**\*WARNING:** Each paper or fee filed by "Express Mail" **must** have the number of the "Express Mail" mailing label placed thereon prior to mailing. 37 C.F.R. section 1.10(b).

"Since the filing of correspondence under section 1.10 without the Express Mail mailing label thereon is an oversight that can be avoided by the exercise of reasonable C.F.R.e, requests for waiver of this requirement will **not** be granted on petition." Notice of Oct. 24, 1996, 60 Fed. Reg. 56,439, at 56,442.

## INFORMATION DISCLOSURE STATEMENT

NOTE: "An information disclosure statement shall be considered by the Office if filed by the applicant:

- (1) Within three months of the filing date of a national application;
- (2) Within three months of the date of entry of the national stage as set forth in section 1.491 in an international application; or
- (3) Before the mailing date of a first Office action on the merits, whichever event occurs last." 37 C.F.R. section 1.97(b).

NOTE: "Each individual associated with the filing and prosecution of a patent application has a duty of candor and good faith in dealing with the Office, which includes a duty to disclose to the Office all information known to that individual to be material to patentability as defined in this section." 37 C.F.R. section 1.56(a).

"Individuals associated with the filing or prosecution of a patent application within the meaning of this section are:

- (1) each inventor named in the application;
- (2) each attorney or agent who prepares or prosecutes the application; and
- (3) every other person who is substantively involved in the preparation or prosecution of the application and who is associated with the inventor, with the assignee or with anyone to whom there is an obligation to assign the application." 37 C.F.R. section 1.56(c).

NOTE: The "duty as described in section 1.56 will be met so long as the information in question was cited by the Office or submitted to the Office in the manner prescribed by sections 1.97(b) - (d) and 1.98 before issuance of the patent." Notice of January 9, 1992, 1135 O.G. 13-25 at 17.

**WARNING:** "No information disclosure statement may be filed in a provisional application." 37 C.F.R. section 1.51(b).

### List of Sections Forming Part of This Information Disclosure Statement

The following sections are being submitted for this Information Disclosure Statement:

(check sections forming a part of this statement: disC.F.R.d unused sections and number pages consecutively)

1. ☒ Preliminary Statements
2. ☒ Forms PTO/SB/08A and 08B (substitute for Form PTO-1449)
3. ☐ Statement as to Information Not Found in Patents or Publications
4. ☐ Identification of Prior Application in Which Listed Information Was Already Cited and for Which No Copies Are Submitted or Need Be Submitted
5. ☐ Cumulative Patents or Publications
6. ☒ Copies of Listed Information Items Accompanying This Statement
7. ☒ Concise Explanation of Non-English Language Listed Information Items
  - 7A. ☐ JEPO Search Report
  - 7B. ☒ English Language Version of EPO Search Report
8. ☐ Translation(s) of Non-English Language Documents
9. ☐ Concise Explanation of English Language Listed Information Items (Optional)
10. ☒ Identification of Person(s) Making This Information Disclosure Statement

(complete the following, if appropriate)

Sections \_\_\_\_\_, respectively, have been continued on ADDED PAGE(S).

NOTE: "Once the minimum requirements are met, the examiner has an obligation to consider the information." Notice of April 20, 1992 (1138 O.G. 37-41, 37).

## **Section 1. Preliminary statements**

Applicants submit herewith patents, publications or other information, of which they are aware that they believe may be material to the examination of this application, and in respect of which, there may be a duty to disclose.

The filing of this information disclosure statement shall not be construed as a representation that a search has been made (37 C.F.R. section 1.97(g)), an admission that the information cited is, or is considered to be, material to patentability, or that no other material information exists.

The filing of this information disclosure statement shall not be construed as an admission against interest in any manner. Notice of January 9, 1992, 1135 O.G. 13-25, at 25.

**SECTION 2. FORMS PTO/SB/08A and 08B (formerly Form PTO-1449)**

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Zimmerling et al. Attorney Docket: 1941/172  
 Serial No: 10/726,066 Art Group Unit: 3751  
 Date Filed: December 2, 2003 Examiner Name: Rost, Andrew J.  
 Invention: Fluid Switch Controlled Transcutaneously via a Magnetic Force

**LIST OF PATENTS AND PUBLICATIONS FOR  
 APPLICANT'S INFORMATION DISCLOSURE STATEMENT**

U.S. PATENT DOCUMENTS					
Examiner Initials	Reference Number	Document Number	Issue Date/ Publication Date	Inventor	Class/Subclass
	AA	US 4,207,554	Jun. 10, 1980	Resnick et al.	340/146.3 CA
	AB	US 5,630,839	May 20, 1997	Corbett et al.	607/137
	AC	US 5,800,500	Sep. 1, 1998	Spelman et al.	607/137
	AD	US 5,876,443	Mar. 2, 1999	Hochmair et al.	623/10
	AE	US 5,891,183	Apr. 6, 1999	Zierhofer	607/57
	AF	US 5,922,017	Jul. 13, 1999	Bredberg et al.	607/137
	AG	US 5,983,139	Nov. 9, 1999	Zierhofer	607/56
	AH	US 5,999,859	Dec. 7, 1999	Jolly	607/137
	AI	US 6,231,604 B1	May 15, 2001	Ilberg	623/10
	AJ	US 2002/0019669A1	Feb. 14, 2002	Berrang et al.	623/10
	AK	US 6,348,070 B1	Feb. 19, 2002	Teissl et al.	623/11.11
	AL	US 6,361,494 B1	Mar. 26, 2002	Lindenthaler	600/373
	AM	US 6,535,153 B1	Mar. 18, 2003	Zierhofer	341/143
	AN	US 6,556,870 B2	Apr. 29, 2003	Zierhofer et al.	607/57
	AO	US 6,594,525 B1	Jul. 15, 2003	Zierhofer	607/57
	AP	US 6,600,955 B1	Jul. 29, 2003	Zierhofer	607/57
	AQ	US 6,661,363 B2	Dec. 9, 2003	Zierhofer	341/143
	AR	US 2004/0039245A1	Feb. 26, 2004	Jaeger et al.	600/25
	AS	US 6,727,833 B2	Apr. 27, 2004	Zierhofer	341/143
	AT	US 2004/0133250A1	Jul. 8, 2004	Ball	607/57
	AU	US 6,838,963 B2	Jan. 4, 2005	Zimmerling et al.	335/205
	AV	US 6,885,326 B2	Apr. 26, 2005	Zierhofer	341/143

FOREIGN PATENT DOCUMENTS						
Examiner Initials	Reference Number	Country Code	Document Number	Publication Date	Patentee or Applicant	Class/Subclass
	AW	WO	81/00209	05/02/81	Univ. of Minnesota	A61M 1/00
	AX	DE	3242870 A1	01.06.83	Machid Endoscope Co.	A61 B10/00
	AY	EP	0564321A2	06/10/93		A61M 39/02
	AZ	DE	29513195U1	19.12.96	Schreiber, Hans	A61M 1/14
	BA	WO	98/52640	26.11.98	Q-Core Ltd.	A61M 31/00
	BB	DE	19960131 A1	05.07.01	Adeva Medical	A61M 39/02

Examiner Signature: \_\_\_\_\_

Date Considered: \_\_\_\_\_

EXAMINER: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation *if not* in conformance and not considered. Include copy of this form with next communication to applicant.

## Section 6. Copies of Listed Information Items Accompanying This Statement

*NOTE: 37 C.F.R. section 1.98(a)(2) requires that any information disclosure statement filed under section 1.97 shall include: "A legible copy of: (i) Each U.S. and foreign patent; (ii) Each publication or that portion which caused it to be listed; and (iii) All other information or that portion which caused it to be listed, except that no copy of a U.S. patent application need be included. . ."*

*NOTE: The wording in section 1.98(a)(2)(iii) makes it clear that the requirement to submit a copy of each item of information listed in an information disclosure statement does not apply to the citation of a U.S. patent application. Notice of January 9, 1992, 1135 O.G. 13-25, at 14.*

Legible copies of all items listed in Forms PTO/SB/08A and 08B (substitute for Form PTO-1449) accompany this information statement.

*(complete the following, if applicable)*

☒ Exception(s) to above:

☐ Items in prior application, from which an earlier filing date is claimed for this application, as identified in Section 4.

☐ Cumulative patents or publications identified in Section 5.

U.S. patent citations are not included pursuant to 37 CFR 1.98 9(a)(2)(i) and 37 CFR 1.491(b), in which the USPTO waived the requirement for submitting a copy of each cited U.S. patent and each U.S. patent application publication for all U.S. national patent applications filed after June 30, 2003 and for all international applications that have entered the national stage under 35 USC § 371 after June 30, 2003.



## **Section 7. Concise Explanation of Non-English Language List Information Items**

**NOTE:** *"A concise explanation of the relevance, as it is presently understood by the individual designated in section 1.56(c) most knowledgeable about the content of the information of each patent, publication, or other information listed that is not in the English language shall be included in any information disclosure statement filed under section 1.97. The concise explanation may be either separate from the specification or incorporated therein." 37 C.F.R. section 1.98(a)(3).*

**NOTE:** *"[T]he explanation required is limited to the relevance as understood by the individual designated in section 1.56(c) most knowledgeable about the content of the information at the time the information is submitted to the Office." Notice of January 9, 1992, 1135 O.G. 13-25 at 14.*

**NOTE:** *"Where the information listed is not in the English language, but was cited in a search report by a foreign patent officer, the requirement for a concise explanation of relevance is satisfied by submitting an English language version of the search report." Notice of January 9, 1992, 1135 O.G. 13-25. at 14.*

**NOTE:** *"The concise explanation requirement for non-English language information may be met by submission of an English language version of the search report indicating the degree of relevance found by the foreign office." Notice of January 9, 1992, 1135 O.G. 13-25, at 20.*

**WARNING:** *"The requirement in section 1.98(a)(3) for a concise explanation of non-English language information would not be satisfied by a statement that a reference was cited in the prosecution of a parent application." Notice of January 9, 1992, 1135 O.G. 13-25 at 20 (emphasis added).*

**Section 7A. Concise Explanation of Non-English Language Listed Information Items in EPO Search Report**

The relevance with respect to the following citations listed on Forms PTO/SB/08A and 08B (substitute for PTO-1449):

is submitted on the basis of the accompanying:

*(check the appropriate item)*

☒ EPO search report that is in the English language,

☐ EPO search report that is not in the English language and that is accompanied also by an English language version of the EPO search report, that issued on the corresponding European patent application.

**Section 10. Identification of Person(s) Making This Information Disclosure Statement**

The person making this certification is

*(check each applicable item)*

(a) ☐ the inventor(s) who signs below

\_\_\_\_\_  
**SIGNATURE OF INVENTOR**

\_\_\_\_\_  
*(type name of inventor who is signing)*

(b) ☐ an individual associated with the filing and prosecution of this application (37 C.F.R. section 1.56(c))

\_\_\_\_\_  
**SIGNATURE OF INVENTOR**

\_\_\_\_\_  
*(type name of inventor who is signing)*

(c) ☒ the practitioner who signs below on the basis of the information:

*(check each applicable item)*

☐ supplied by the inventor(s).

☐ supplied by an individual associated with the filing and prosecution of this application. (37 C.F.R. section 1.56(c)).

☒ in the practitioner's file.

  
\_\_\_\_\_  
**SIGNATURE OF PRACTITIONER**

Jay Sandvos

\_\_\_\_\_  
*(type or print name of practitioner)*

125 Summer Street, 11<sup>th</sup> Floor

\_\_\_\_\_  
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Boston, MA 02110

Reg. No.: 43,900

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